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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/965,163	09/27/2001	Shridhar P. Joshi	47079-0117	3932

7590 07/29/2002

Michael J. Blankstein
WMS Gaming Inc.
800 South Northpoint Boulevard
Waukegan, IL 60085

EXAMINER
RADA, ALEX P

ART UNIT	PAPER NUMBER
3713	

DATE MAILED: 07/29/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/965,163	JOSHI, SHRIDHAR P.	
	Examiner	Art Unit	
	Alex P. Rada	3713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *10 May 2002* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-26* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-26* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

DETAILED ACTION

Response to Amendment

In response to the amendment filed May 10, 2002, in which the applicant has amended claims 1 and 18 and claims 1-26 are pending in this application.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 1-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Adams `098 in view of Schneider `976 and Small `730.

3. Adams discloses receiving a wager to initiate play of a game on a gaming machine and the game including a random selection of a game outcome as recited in claims 1, 14, and 18. Adams does not expressly disclose dispensing a sweepstakes entry from the gaming machine in response to predetermined criteria as recited in claims 1, 14, and 18. The predetermined criteria include the selected outcome being a predetermined one or more of the plurality of possible outcomes as recited in claims 2, 14-15 and 19. The possible outcomes are associated with a payout exceeding a predetermined threshold as recited in claims 3, 16, and 20. The predetermined criteria include the selected outcome being associated with a payout exceeding a predetermined threshold as recited in claims 4 and 21. A response to a predetermined outcome selected in the game as recited in claims 5 and 22. Receiving a wager to initiate play of the game

and randomly selecting an outcome from a plurality of possible outcomes as recited in claims 12 and 25. Representing the selected game outcome on a visual display as recited in claim 14. Schneider teaches a gaming machine having an outcome being a predetermined one or more of the plurality of possible outcomes, the possible outcomes are associated with a payout exceeding a predetermined threshold, the predetermined criteria include the selected outcome being associated with a payout exceeding a predetermined threshold, a response to a predetermined outcome selected in the game, receiving a wager to initiate play of the game and randomly selecting an outcome from a plurality of possible outcomes, and representing the selected game outcome on a visual display. By having predetermined criteria of different possible outcomes with a payout exceeding predetermined thresholds, one of ordinary skill in the art would be able to increase the enjoyment of a game.

Adams and Schneider do not disclose dispensing a sweepstakes entry from a gaming machine. Small teaches the capability of promotional schemes being used to encourage the usage of an apparatus by adding a sweepstakes entry into a game for each time the apparatus is being used by a game player. By adding a sweepstakes entry to the back of a ticket or receipt of a game machine, one of ordinary skill in the art would be able to increase a game players chances for a bigger prize or payout. It would have been obvious to one of ordinary skill in the art at the time of the applicant's was made to modify Adams to include an outcome being a predetermined one or more of the plurality of possible outcomes, the possible outcomes are associated with a payout exceeding a predetermined threshold, the predetermined criteria include the selected outcome being associated with a payout exceeding a predetermined threshold, and receiving a wager to initiate play of the game and randomly selecting an outcome from a

plurality of possible outcomes as taught by Schneider and a sweepstakes entry from the gaming machine in response to a predetermined criteria as taught by Small. To do so would be able to promote the usage of the game machines by having a game player venture against other game players playing for a grand prize.

Also, for the purpose of the rejection of claims 6-11, 17 and 23-24, it would have been obvious to design a sweepstakes entry form made on pre-printed paper, filling out the needed information, and dropping off the entry or mailing the entry to determine an overall winner in a game. Furthermore, for the purpose of the rejection of claims 13 and 26, it would have been obvious to have a group consisting of slots, poker, keno, bingo, and blackjack to enable a game player to choose a game to his or her liking.

Response to Arguments

4. Applicant's arguments filed May 10, 2002 have been fully considered but they are not persuasive.

5. In response to applicant's argument that Small is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the suggestion to add a sweepstakes is clearly in Small, a reference which is within the same field of endeavor (the increasing use of an electronic machine) as the base references and the instant invention. The Small reference was relied upon to teach what was missing in the combination of the Adams and Schneider.

Definitely the teaching of the Small reference would come under consideration when looking to increase the usage of a gaming machine.

6. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the lacking element of the combination of Adams and Schneider can be found within the reference of Small. The result of the combination of Adams and Schneider were not solutions directed to the dispensing of the sweepstakes entry, but to the predetermined criteria to receive a ticket. The lacking element of the combination of Adams and Schneider is based on the teachings of Small. Small teaches the capability of promotional schemes being used to encourage the usage of an apparatus by adding sweepstakes entry into a game for each time the apparatus is being used. Therefore, it would have been obvious to one of ordinary skill in the art to modify Adams dispensing a ticket to include a random selection of predetermined criteria as taught by Schneider and a sweepstakes entry from a gaming machine from a predetermined criteria as taught by Small. To do so would be able to promote the usage of the game machines by having a game player venture against other game players playing for a grand prize.

The declaration Shridhar P. Joshi filed May 10,2002 is insufficient to overcome the rejection of claims 1-26 based upon the obviousness rejection of 35 U.S.C. 103(a) as set forth in

the last Office action because: The mere opinion of the applicant's commercial knowledge and business success in games does not provide grounds in the determination of nonanalogous. The applicant fails to present factual evidence or any relation to the success to the claimed invention.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alex P. Rada whose telephone number is 703-308-7135. The examiner can normally be reached on Monday - Friday, 08:00-16:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Valencia Martin-Wallace can be reached on 703-308-4119. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

Alex P. Rada
Examiner
Art Unit 3713

apr
apr
July 24, 2002

MICHAEL O'NEILL
PRIMARY EXAMINER